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09/329,182	06/10/1999	GREGORY A. LECLAIR	07426.0001-0	7787

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EXAMINER

NGUYEN, THU HA T

ART UNIT	PAPER NUMBER
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2155

29

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/329,182

Applicant(s)

LECLAIR ET AL.

Examiner

Thu Ha T. Nguyen

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5, 7-8, 13-14, 19-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,8,13,14 and 19-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 3-5, 7-8, 13-14 and 19-48 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining whether the subject matter defined in the claims is described in the specification.

3. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in the art to recognize the destination device sends information to said input device to identify a destination address for a remote storage device and said input device sends the received input data to said remote storage device in accordance with said destination device.

Claims 1, 5, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitation exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention. Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in the art to recognize the following steps as recited in claims 1, 5, and 13:

"...destination device send information to said input device identifying a destination address for a remote storage device..." and

"...said input device... sending the received input data to said remote storage device in accordance with said destination device."

4. Claims 1, 5, and 13 are unclear that the one ^{of} ordinary skilled in the art cannot recognize the encompassed claim limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2155

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-5, 7-8, 13-14, and 19-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Unno** U.S. Patent No. **6,437,875**, in view of **Manglapus et al.**, (hereinafter Manglapus) U.S. Patent No. **6,219,151**.

6. As to claims 1, and 5, **Unno** teaches the invention as claimed, including a method for remote execution of an application over a network including a destination device and an input device, wherein said destination device is external and separate from said input device (figure 1), the method comprising the operations of:

having said input device receive input data (abstract, figure 1, element 1001),

having said destination device send information to said input device identifying a destination address for a remote storage device accessible over said network and remote from said input device and said destination device (figures 1, 12, 13, 72, 73, col. 10 lines 40-col. 11 lines 63, col. 13 lines 58-col. 14 lines 39),

having said input device respond to said receiving of said input data by sending the received input data to said remote storage device in accordance with said destination address, and sending notification to said destination device indicating that input data is ready for pickup at said remote storage device (figures 1, 12, col. 5 lines 13-50, col. 10 lines 40-col. 11 lines 63, col. 27 lines 2-35);

having said destination device initiate the retrieval of said input data (figures 1, 12, 13, col. 5 lines 25-45, col. 10 lines 40-col. 11 lines 63).

Art Unit: 2155

Even though **Unno** does not explicitly teach sending notification to said destination device indicating that input data is ready for pickup at said remote storage device; however, **Unno** teaches the image processing apparatus stores input data into database server, E-mail server, DNS server, then database client, E-mail client can receive, retrieve and transmitting input data via E-mail by E-mail server (figure 1, col. 5 lines 25-50). Therefore, this feature is deemed to be obvious to one of ordinary skill in the art at the time of the invention was made to have the E-mail client receive E-mail via E-mail server as a notification in order to retrieve and read the image data from server. Moreover, in order to support the obviousness of the notification step, **Manglapus** teaches the printer sends an acknowledgement and SNMP traps to client indicating the location of stored print job (figures 4-5). It would have been obvious to one of ordinary skill in the art to modify the process of **Unno** to include the notification process of **Manglapus** because it would provide an efficient and reliable system of establishing direct communication between client and input device.

7. As to claims 3, and 7, **Unno** teaches the invention as claimed, further comprising having said input device receive a request specifying a preferred file format; and having said input device convert said received input data to said preferred file format (col. 13 lines 58-col. 14 lines 39, col. 20 lines 53-col. 21 lines 21, col. 23 lines 25-47).

Art Unit: 2155

8. As to claims 4, and 8, **Unno** teaches the invention as claimed, further comprising having said input device transmit status information in response to a status request (col. 21 lines 66-col. 22 lines 33).

9. As to claim 13, **Unno** teaches the invention as claimed, including a network data control system comprising:

an input device for receiving input data, said input device having access to a network (figure 1),

a destination device remote from said input device and having access to said network (figures 1, 13, col. 5 lines 25-50, col. 13 lines 11-15);

a remote storage device accessible via said network and remote from said input device and said destination device (figures 1, 13, col. 5 lines 25-50, col. 13 lines 11-15); wherein

said destination device is effective for transmitting to said input device information identifying a destination address for said remote storage device (figures 1, 13, col. 25-50);

said input device is effective for transferring the input data to said remote storage device and transmitting a notification to said destination device including instructions for accessing the input data from said remote storage device (figures 1, 12, col. 5 lines 13-50, col. 10 lines 40-col. 11 lines 63, col. 27 lines 2-35); and

said destination device retrieving the input data from one of said input device and said remote storage device (figures 1, 12, 13, col. 5 lines 25-45, col. 10 lines 40-col. 11 lines 63).

Even though **Unno** does not explicitly teach transmitting notification to said destination device instruction for accessing the input data from said remote storage device; however, **Unno** teaches the image processing apparatus stores input data into database server, E-mail server, DNS server, then database client, E-mail client can receive, retrieve and transmitting input data via E-mail by E-mail server (figure 1, col. 5 lines 25-50). Therefore, this feature is deemed to be obvious to one of ordinary skill in the art at the time of the invention was made to have the E-mail client receive E-mail via E-mail server as a notification in order to retrieve and read the image data from server. Moreover, in order to support the obviousness of the notification step, **Manglapus** teaches the printer sends an acknowledgement and SNMP traps to client indicating the location of stored print job (figures 4-5). It would have been obvious to one of ordinary skill in the art to modify the process of **Unno** to include the notification process of **Manglapus** because it would provide an efficient and reliable system of establishing direct communication between client and input device.

10. As to claim 14, **Unno** teaches the invention as claimed, wherein said input device is a network scanner (figure 1).

.Art Unit: 2155

As to claim 19, **Unno** teaches the invention as claimed, including a network image data transfer system comprising:

an image input device for generating image data, said image input device having access to a network (figure 1);

a client device having access to said network, said client device being external and separate from said input device (figures 1, 13, col. 5 lines 25-50, col. 13 lines 11-15);

a remote storage device accessible via said network and remote from said image input device and said client device (figures 1, 13, col. 25-50); wherein

said image device transfers said image data to said remote storage device (figures 1, 12, col. 5 lines 13-50, col. 10 lines 40-col. 11 lines 63, col. 27 lines 2-35); and

said client device retrieving said image data over said network from said remote storage device (figures 1, 12, 13, col. 5 lines 25-45, col. 10 lines 40-col. 11 lines 63).

Even though **Unno** does not explicitly teach transmitting a notification to said client device including instructions for accessing said image data from said remote storage device; however, **Unno** teaches the image processing apparatus stores input data into database server, E-mail server, DNS server, then database client, E-mail client can receive, retrieve and transmitting input data via E-mail by E-mail server (figure 1, col. 5 lines 25-50). Therefore, this feature is deemed to be obvious to one of ordinary skill in the art at the time of the invention was made to have the E-mail client receive E-mail via E-mail server as a notification in order to retrieve and read the image data from server. Moreover, in order to support the obviousness of the notification step,

Art Unit: 2155

Manglapus teaches the printer sends an acknowledgement and SNMP traps to client indicating the location of stored print job (figures 4-5). It would have been obvious to one of ordinary skill in the art to modify the process of **Unno** to include the notification process of **Manglapus** because it would provide an efficient and reliable system of establishing direct communication between client and input device.

11. As to claim 20, **Unno** teaches the invention as claimed, wherein said notification includes information for locating said image data within the file structure of said remote storage device (col. 27 lines 1-16).

12. As to claim 21, **Unno** teaches the invention as claimed, wherein said instructions include a Uniform Resource Locator, URL, for accessing said image data from said remote storage device (col. 18 lines 35-col. 19 lines 67).

13. As to claim 22, **Unno** teaches the invention as claimed, wherein said network is the Internet (figure 1).

14. As to claim 23, **Unno** teaches the invention as claimed, wherein said image input device stores said image data and makes it accessible through HTTP communication protocol, and provides information for accessing said stored image data within said notification (figure 1, col. 10 lines 40-67, col. 13 lines 17-col. 15 lines 5).

Art Unit: 2155

15. As to claim 24, **Unno** teaches the invention as claimed, wherein said image input device is further effective for receiving the network addresses of a plurality of said client devices, and transmits said notification to a select group of client devices within said plurality of client devices (figures 1, 12, col. 5 lines 13-50, col. 10 lines 40-col. 11 lines 63, col. 27 lines 2-35).

16. As to claim 25, **Unno** teaches the invention as claimed, wherein the client devices within said select group each independently initiates the retrieval of said image data using the HTTP GET protocol (figure 12, col. 10 lines 40-67, col. 13 lines 17-col. 15 lines 5).

17. As to claim 26, **Unno** teaches the invention as claimed, wherein said client device submits the network address of said remote storage device to said image input device, and said image input device accesses said remote storage device using submitted network address (figures 1, 12, col. 5 lines 13-50, col. 10 lines 40-col. 11 lines 63, col. 27 lines 2-35).

18. As to claim 27, **Unno** teaches the invention as claimed, wherein said notification includes parameter data descriptive of said image data, and said client device initiates the retrieval of said image data only if it determines that its physical parameters are capable of manipulating said image data (figure 12, col. 10 lines 40-64).

Art Unit: 2155

19. As to claim 28, **Unno** teaches the invention as claimed, wherein said parameter data includes at least the resolution of said image data, and the decision whether to retrieve said image data is dependent on the specified resolution of said image data and whether said client device can handle the specified resolution (figure 12, col. 7 lines 60-col. 8 lines 3, col. 10 lines 40-64, col. 13 lines 45-col. 14 lines 39).

20. As to claim 29, **Unno** teaches the invention as claimed, wherein prior to retrieving said image data, said client device submits a preferred file format to said image input data device, and retrieves said image data only if said image data is in said preferred file format (col. 13 lines 58-col. 14 lines 39, col. 20 lines 53-col. 21 lines 21, col. 23 lines 25-47).

21. As to claim 30, **Unno** teaches the invention as claimed, wherein said image input device responds to said submission of said preferred file format from said client device by converting said image data into said preferred file format if said image data is not already in said preferred file format (col. 13 lines 58-col. 14 lines 39, col. 20 lines 53-col. 21 lines 21, col. 23 lines 25-47).

22. As to claim 31, **Unno** teaches the invention as claimed, wherein said preferred file format is one of GIF format, JPEG format, or other file compression format (vol. 11 lines 65-col. 12 lines 13, col. 14 lines 12-39).

Art Unit: 2155

23. As to claim 32, **Unno** teaches the invention as claimed, wherein said image input device is further effective for receiving the network address of said client device, and transmits said notification to said client device according to said received network address (figures 1, 12, col. 5 lines 13-50, col. 10 lines 40-col. 11 lines 63, col. 27 lines 2-35).

24. As to claim 33, **Unno** teaches the invention as claimed, wherein said input device is one of a scanner, camera, and facsimile machine (figure 1).

25. As to claim 48, **Unno** teaches the invention as claimed, including a computer-readable medium containing instructions for implementing the method of claim 34, and transferring image data in said network having said image input device, client device and remote storage device (figure 1).

26. Claims 34-47 teach a method for transferring image data in a network direct to the system of claims 19-32. Claims 34-47 have similar limitation as claims 19-32; therefore, they are rejected under the same rationale.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

28. US 6,256,662. Network image scanning system which transmits image information from a scanner over a network to client computer.

Art Unit: 2155

29. US 6,636,891. Method and apparatus for controlling an input/output device over the Internet.

30. US 6,421,069. Method and apparatus for including self-describing information within devices.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Ha Nguyen, whose telephone number is (703) 305-7447. The examiner can normally be reached Monday through Friday from 7:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached at (703) 308-6662.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

The fax number for art unit 2155 is (703) 872-9306.

Thu Ha Nguyen

February 26, 2004


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER